

REMARKS

The above amendments and following remarks are submitted in response to the pending Official Action of the Examiner mailed November 30, 2006. Having addressed all objections and grounds of rejection, claims 1-21, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has objected to the Specification in view of certain missing information concerning co-pending applications. In response thereto, page 1 of the specification has been amended as suggested by the Examiner.

Claims 2-3, 5, 7, 9, 12, and 19-21 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In response thereto, the appropriate claims have been amended as suggested by the Examiner.

However, it is incumbent upon the Examiner to distinguish between the term "JavaScript" utilized as a trademark and the same term not utilized as a trademark. A trademark identifies the source of goods. As such, "JavaScript software package" utilizes "JavaScript", because it identifies the source of the specified software package. On the other hand, "JavaScript object" modifies the noun "object" without identifying the source of the "object". The owner of the "JavaScript" trademark registration does not sell or otherwise supply an "object".

Therefore, only those claims which have actually used "JavaScript" as a trademark have been amended in response to the Examiner's rejection. To the extent that the Examiner has rejected claims which use "JavaScript" as other than a trademark, such rejections are respectfully traversed as not consistent with controlling law.

Claims 1-5 and 11-21 have been rejected under 35 U.S.C. 101 as not directed to statutory subject matter. This ground of rejection is deemed based upon clearly erroneous findings of fact. For example, the Examiner states:

Further, with respect to claims 1, 11 and 21, claims recite an apparatus, however the components of an apparatus are merely software per se.

This statement is clearly erroneous, because claims 1 and 21 are each limited by a "legacy data base management system" (see Fig. 1, element 14). Furthermore, claim 11 is limited by "means-plus-function" limitations which are limited to Applicants' disclosure as a matter of law (see Fig. 1). Nevertheless, Applicants have amended the claims as suggested by the Examiner to further the prosecution.

Claims 1-5 and 11-21 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Applicants acknowledge this provisional rejection and will address the matter upon allowance of all pending claims.

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a). Specifically, he is concerned with his inability to find the claimed "legacy data base management system" and "facility for conversion" within the drawings. In response thereto, the Examiner may wish to consult Fig. 1, element 14, discussed at page 14, lines 17-19 of Applicants' specification regarding the "legacy data base management system".

To assist the Examiner, the claims have been amended to substitute the term "parse" for the term "conversion". The Examiner may find the disclosure in the specification at page 6, lines 3-4, and Fig. 2, element 38.

Claims 1-13 and 16-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2004/0226027, published in the name of Winter (hereinafter referred to as "Winter"). This ground of rejection is respectfully traversed.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because "the identical invention" is not shown by Winter "in as complete detail as is contained in the claims" as is required by MPEP 2131.

The present invention provides an apparatus for and method of utilizing JavaScript to request a complex comparison from a legacy data base management system. The user is thus able to evoke the powerful dataset comparison tools of the legacy data base management system. This approach leverages the power of the legacy data base management without the need for the user to become familiar with the proprietary command language of the legacy data base management system. The approach is particularly efficient in that the user can provide parameters directly to the legacy data base management system as a parameter object defined within the standardized object-based command language.

Winter on the other hand, discusses a method of separating a function of the business logic of an application from a user interface of the application where the business logic and user interface of the application are intermingled. The method includes providing a wrapper interface for the application. The method also includes providing a function of the business logic of the application separated from the user interface of the application through the wrapper interface.

The differences in these approaches are readily apparent in structure and operation. Winter relies upon completely

"wrapping" a legacy system such that all external communication to and from the legacy system must be converted before being delivered to the intended recipient (see Fig. 1, element 104). Thus, the approach tends to be less efficient than Applicants' technique which does not require a wrapper for complete conversion of all communications. For example, in Applicants' system, the claimed "facility for parsing" is provided to the claimed legacy data base management system without any conversion required. In other words, the claimed legacy data base management system performs the necessary conversions by "parsing" the JavaScript command language service request. These differences in approach manifest themselves in structural and functional differences which are best observed in view of analysis of the individual claims.

Amended claim 1, for example, has four basic elements. The first claimed element is "a legacy data base management system having a first command language and having a plurality of datasets". In making his rejection, the Examiner cites processing engine 206, which is the actual "wrapper" (see paragraph 0045). Clearly, processing engine 206 cannot be the claimed element. The Examiner also cites "legacy application user interface" 208. It is unknown why anyone would consider the "legacy application user interface" 208 of Winter to be the claimed "legacy data base management system having a first

command language and having a plurality of datasets", wherein the only similarity is that both contain to term "legacy". It is adds further confusion that the Examiner has cited six full paragraphs of irrelevant material.

The second element, as amended, is "a user terminal which generates a request in a standardized command language for comparing some of said plurality of datasets within said legacy data base". Instead of addressing this element, the Examiner cites element 300 and paragraphs 0031 and 0050-0051 Winter. External system 300 Winter is defined at page 4, paragraph 0050 as:

For example, external system 300 may be a system that interacts with the legacy system via electronic messaging. External system 300 may be any conceivable component that is able to make a programmatic request to API adapter 302 and that may pass API adapter 302 a data message (i.e., user less system or headless).
(emphasis added)

It is inconceivable that one could consider a "user less system" to be the claimed "user terminal". In other words, Winter says that external system 300 could be anything but the claimed "user terminal", because the claimed "user terminal" requires a user by definition.

In addition, the Examiner has cited paragraph 0031 which has nothing to do with external system 300. Furthermore, none of the cited paragraphs 0031, 0050, or 0051 says anything of the claimed

"standardized command language". In fact the cited paragraphs say nothing of any command language.

The third claimed element, as amended, is "a facility located within said legacy data base management system which parses said request in said standardized command language into a corresponding request in said first command language". In making his rejection, the Examiner cites API adapter 302. This makes little sense as paragraph 0054 states in part:

API adapter 302 works with processing rules 304 in order to make decisions that would be made by an actual physical user if the session utilized an actual physical user interface.

In other words, not only does API adapter 302 not parse the claimed service request generated by the claimed "user terminal", it acts like a "user terminal", because the system of Winter does not have a user terminal.

The fourth claimed element is "a result produced by said legacy data base management system indicative of honoring said corresponding request". The claimed "result" must be produced by said legacy data base management system. Nevertheless, the Examiner cites paragraph 0047 which discusses processing engine 206 and paragraph 0054 which discusses API adapter 302, as if these elements had anything to do with the claimed invention. This finding is legally irrelevant, because it does not disclose the claimed "result" as "produced by said legacy data base management system".

As a result of Winter having none of the four claimed elements of amended claim 1, the rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Notwithstanding the differences in claimed limitations amongst claims 1, 6, 11, 16, and 21, the Examiner apparently has not felt the need to actually examine claims 6, 11, 16, and 21 as required by controlling law. Therefore, the rejection of amended claims 6, 11, 16, and 21, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to examine them.

Claims 2-3, 7, 9, 12, 17, and 19-20 depend from claims 1, 6, 8, 11, 16, and 18, respectively, and further limit the claimed service request and corresponding claimed result. In making his rejection, the Examiner irrelevantly cites paragraphs 0030, 0041, and 0059, none of which showing, mentioning, or teaching any service request or result as claimed. The rejection of claims 2-3, 7, 9, 12, 17, and 19-20 is respectfully traversed.

Claims 4, 8, 10, 13, and 18 depend from claims 3, 7, 9, and 17, respectively, and further limit the network coupling the major hardware components. In making his rejection, the Examiner cites paragraph 0051 and Fig. 3, neither of which showing, mentioning, or teaching any particular coupling network. The rejection of claims 4, 8, 10, 13, and 18 is respectfully traversed.

Claim 5 depends from claim 4 and is further limited by "wherein said data base management system further comprises a data base having a plurality of columns of data wherein each of said plurality of datasets corresponds to a different one of said plurality of columns of data". Because the Examiner is aware that Winter cannot meet these limitations, the Examiner cites paragraph 0070, which he knows does not disclose the claimed elements. The rejection of claim 5 is respectfully traversed.

Claims 1-21 have been rejected under 35 U.S.C. 102(e)¹ as being anticipated by U.S. Patent Publication 2003/0051070, published in the name of Shappir et al (hereinafter referred to as "Shappir"). This ground of rejection is respectfully traversed.

Unlike Applicants' invention as disclosed and claimed, Shappir discusses a technique for completely separating the functions of the legacy data base management system from the user interface. Shappir accomplishes this by interposing a server between the user and the data base management system which emulates a legacy user terminal to the legacy data base management system.

The differences in these approaches are readily apparent in structure and operation. Shappir permits the legacy data base

¹This is probably a typographical error. It is assumed that the Examiner wished to reject claims 1-21 under 35 U.S.C. 102(b).

management system to be completely unmodified. However, Shappir requires another server in which to store the logic for and execute the emulation logic.

Applicants' approach, on the other hand, requires minor additions to the legacy data base management system, but does not require a separate server for the interface of the "service requests". Furthermore, the full power of the legacy data base management system becomes available to implement the conversion process.

Amended claim 1, for example, has four basic elements. The third claimed element is "a facility located within said data base management system which parses said request in said standardized command language into a corresponding request in said first command language". The amendments to this element are fully supported in Applicants' disclosure and summarized at page 10, lines 9-16. As admitted by the Examiner, Shappir does not have any facility which performs the claimed conversion. Clearly, Shappir does not meet this limitation, because it requires a separate and independent server to provide the necessary interface.

As a result of Shappir not having at least the third claimed element of amended claim 1, the rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Notwithstanding the differences in statutory, judicial, and administrative standards of patentability and the claimed limitations between claims 1 and claims 2-21, the Examiner apparently has not felt the need to actually examine claims 2-21 as required by controlling law. For example, claim 11 contains four "means-plus-function" limitations which must be examined in accordance with MPEP 2181-2184. Therefore, the rejection of amended claims 2-21 is respectfully traversed for failure of the Examiner to examine them in accordance with controlling law.

Claims 14-15 have been rejected under 35 U.S.C. 103(a) as unpatentable over Winter in view of Applicant Admitted Prior Art (AAPA). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

As to the requirement to show motivation, the Examiner concludes:

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Winter's system by using the Mapper data base management system structure in order to have data base management system in an efficient, multi-user environment for the stated purpose has been well known in the art as evidenced by teaching of AAPA (see first paragraph, page 2).

However, Winter has no data base management system at all. Furthermore, the Examiner does not allege that it does. Therefore, there can be no motivation per se for improve the efficiency of Winter's data base management system by making it the claimed MAPPER system.

The Examiner does not venture any showing of reasonable likelihood of success as required by MPEP 2143. However, he could not do so, because of the readily apparent incompatibilities of AAPA and Winter.

Finally, the Examiner fails to show all of the claimed elements. The claimed "storing means" must be "responsively coupled to said requesting means via said publically accessible digital data communication network". If the Examiner were to read AAPA, he would find the reasons why Mapper could not be so coupled, absent Applicants' invention. The rejection of claims 14-15 is respectfully traversed for failure of the Examiner to make any of the three showings required by MPEP 2143.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-21 being the only pending claims.

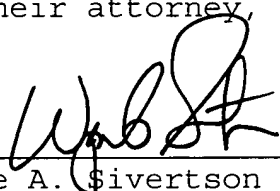
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Respectfully submitted,

Barbara A. Christensen et al.

By their attorney,

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Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, MN 55413
(612) 331-1464